



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/813,023 | 03/21/2001 | Junji Seki | 1095.1176 | 2740 |

21171 7590 04/07/2004

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

| |
|----------|
| EXAMINER |
|----------|

GARG, YOGESH C

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|------------|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/813,023 | SEKI ET AL. | |
| | Examiner | Art Unit | |
| | Yogesh C Garg | 3625 | <i>MLC</i> |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date 2. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-5, 7, and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Saigo (US Patent 6,142,628).

Note: Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Regarding claim 1, Saigo discloses a sales transaction support method for supporting a sale of a commodity (see at least FIG.26 which discloses a support system and method for a sales transaction for eyeglasses. Also see col.1, lines 5-62 and col.4, lines 21-26), comprising:

Art Unit: 3625

a commodity-presenting step for presenting said commodity (see at least col.3, line 66-col.4, line 10, *"..... a review function screen for displaying and examining at least frame type, frame lens shape, and frame price, on a screen, Since frame type, frame lens shape, and frame price are displayed simultaneously on a screen, a multifaceted, comprehensive judgment can be easily made in deciding on an eyeglasses frame by examining an eyeglasses frame on the basis of the frame data thereof.* " ; Note: This is a step wherein eye frame (commodity) is presented).

a try-on simulation step for providing a try-on simulation image of an object virtually wearing said commodity by using commodity image information of an image of said commodity presented by said commodity-presenting process and object image information of an image of said object (see at least col.4, lines 28-51, *" an eyeglasses try-on simulation system of the present invention (Constitution 13) is characterized in that it comprises a function for capturing and displaying on a display screen as image data a portrait of a person, who is not wearing glasses; a function for selecting an arbitrary eyeglasses frame from among eyeglasses frame data, comprising images of a plurality of types of eyeglasses frames stored in advance; a function for composing an eyeglasses frame image of the above-mentioned selected eyeglasses frame and the above-mentioned portrait image, and for displaying on the above-mentioned display screen a composite image on which the eyeglasses frame is simulated; and a function for performing image processing, which adds, relative to the transmittance image of a lens portion of the above-mentioned composite image, an external appearance effect in accordance with prescription lens refraction.....Therefore, an eyeglasses wearer is able to make an accurate decision regarding eyeglasses that meet his expectations.* " . Note: In Saigo the object is a person who is buying the eyeglasses and a try-on simulation step is disclosed for providing a try-on simulation image of a person virtually wearing said eyeglasses by using eyeglasses

Art Unit: 3625

image information of an image of said eyeglasses presented by the system/process and object image information of an image of said person); and

a transaction step for executing a transaction process for said commodity (see at least col.4, lines 21-26, "*.... it comprises an order placing function for processing an order placement, comprising eyeglasses frame data, and lens data processing instructions required for manufacturing eyeglasses after eyeglasses specifications have been determined.* ". Note: the order placing function corresponds to executing a transaction.

Regarding claims 3-4, Saigo discloses a customer information processing step for registering customer information of a user, and wherein said object image information is generated based on said customer information and also said commodity presenting step presents said commodity selected based on said customer information registered by said customer information processing step (see at least FIGs.2 [see "customer Registration field], FIG.-3, and col.8, line 64-col.9, line 15 which disclose that the relevant data about the customer is inputted in a customer file [see FIG.1] and the same is retrieved and used in the simulation process involving both the image of the object, that is the person and the eyeglasses which are to be purchased).

Regarding claim 5, Saigo further discloses that the sales transaction support method according to claim 1, wherein said presentation of said commodity by said commodity-presenting step, said provision of said try-on simulation image by said try-on simulation step, and said transaction process by said transaction step are

Art Unit: 3625

performed via a telecommunication network. (see at least col.22, line 61-col.23, line 14, “ *However, as is clear from the above description, since eyeglasses specifications can be determined using the frame data, lens data in the eyeglasses try-on simulation system of this embodiment, and all eyeglasses manufacturing [processes] can be ordered from an outside vendor on the basis of the eyeglasses specifications thereof, by making use of a computer-based communications network (the HOYA Online System, for example), [this system] can also be utilized by locations that have absolutely no real frames or lenses in stock. Therefore, this system can even be utilized at a clinic and the like, where resident optometrist prepare a lens prescription in accordance with an eye optometry. “).*

Regarding apparatus claims 7, 9-11 and computer readable recording medium claim 12, their limitations are closely parallel to the manipulative steps of claims 1, 3-5 and are therefore analyzed and rejected as being anticipated by Saigo based on the same rational.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 3625

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5.

6. Claims 2, 6 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over Saigo as applied to claim 1 above, and further in view of Official Notice.

Regarding claim 2, Saigo teaches a sales transaction support method as analyzed and discussed in claim 1. Saigo further discloses trying on said commodity at a store selling said commodity (see at least col.7, line 56-col.22, line 14, “ *first, a customer file of a person, who visits an eyeglasses store to place an order for eyeglasses (a customer), is prepared. At this time, a lens prescription in accordance with an optometry of an optometrist is inputted. Next, a portrait of the customer not wearing eyeglasses is taken with a digital camera, and read into the computer, following which, portrait data is prepared by displaying [the portrait] on a display screen,.....* ”. Note: The customer goes to an eyeglasses store for trying on various frames/lenses of different types and colors to select an eyeglass to place an order). Saigo does not disclose making a try-on reservation at the said store. However, the examiner takes an Official Notice of the notoriously well-known concept and benefits of making a reservation for try-on process before going to the store. It is a well-known fact for many many years that a buyer/customer first makes a reservation before visiting an optometrist/eyeglasses store or a doctor for eye-examination and to buy

Art,Unit: 3625

eyeglasses so that his/hers eye examination and customer support is presented to him for trying and selecting eyeglasses at the appointed time for the obvious reason that neither the customer's nor the stores' time is wasted and none of them goes through the inconvenience of having to wait for his/her turn.

Regarding claim 6, Saigo in view of Official Notice teaches a sales transaction support method as analyzed and discussed in claim 2 above and further discloses, wherein said try-on reservation step issues a try-on reservation card having thereon an identification number for identifying said try-on reservation, when said try-on reservation for trying on said commodity is made (see at least FIG.26, "Record Output Confirmation" corresponds to the claimed card having an identification number in the form of "customer Information number" and all other relevant details)..

Regarding apparatus claim 8, its limitations are closely parallel to the manipulative steps of claim 2 and is therefore analyzed and rejected as being obvious over Saigo and further in view of Official Notice based on the same rational.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US patent 6,533,418 B1 to Izumitani et al. discloses a system for making spectacles to order (see abstract at least).

Art. Unit: 3625

(ii) US Patent 5,974,400 to Kagami et al. discloses a trying-on apparel virtually electronically online using simulation principle (see at least col.5, line 52-col.11, line 67).

(iii) US Patent 6,083,267 to Motomiya et al. discloses a system and method for designing an accessory (see at least abstract).

(iv) US Patent 5,515,268 to Yoda discloses a method and system for ordering products accommodating varying customer sizes (see at least col.1, line 1-col.3, line 6).

(v) US Patent 5,680,528 to Korszum discloses a digital dressing room (see at least abstract).

(vi) JP408325821A to Sakaguchi et al. discloses a dressing simulation apparatus (see at least abstract).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Examiner
Art Unit 3625

YCG
March 31, 2004